

REMARKS

A. Background

Claims 21-23 and 25-31 were pending in the application at the time of the Office Action with claims 22, 23, and 25-29 having been withdrawn due to an earlier restriction requirement.¹ Claims 21, 30 and 31 were rejected as being obvious over cited art. By this response applicant has amended claims 21, 30, and 31 as well as withdrawn claims 22, 23, and 27-29; and added new claims 32-36. As such, claims 21 and 30-36 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Amendments

Applicant has herein amended the abstract to more closely reflect the scope of the claimed inventions.

Applicant has herein amended claims 21-23, and 27-31 to further clarify, more clearly define, and/or broaden the claimed inventions to expedite receiving a notice of allowance. For example, claims 21, 30, and 31 have been amended to clarify claim language, remedy formal matters, and to require the glass melt to have the composition and components recited in the preamble of claim 21. Withdrawn claims 22, 23, and 27-29 have also been amended to clarify claim language and to remedy formal matters. The amendments to the claims are supported in the application at least by Figures 26a and 26b and paragraphs [0119] through [0121] of the specification as originally filed.

¹ The Office Action Summary erroneously lists claims 21, 30, and 31 as being withdrawn. Actually, claims 21, 30, and 31 are the only claims pending at the time of the Office Action that have not been withdrawn.

In view of the foregoing discussion, applicant submits that the amendments to the specification and the claims do not introduce new matter and entry thereof is respectfully requested.

C. Objection of the Specification

Paragraphs 3-4 of the Office Action object to the abstract of the disclosure because it allegedly no longer reflects the scope of the selected invention. In light of amendments made herein to the abstract, applicant submits of this objection has been overcome and should be withdrawn.

D. Rejections based on 35 USC § 112

1. Written Description

Paragraphs 5-6 of the Office Action reject claims 21, 30 and 31 under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleges that a specifically cited portion of those claims is not supported in the disclosure. In response, applicant has amended claims 21, 30 and 31 so as to clarify the claims and remedy the rejection. Applicant notes that the amended claim language is supported at least by Figures 26a and 26b, and by paragraphs [0119] – [0121] of the specification. In light of these claim amendments, applicant submits of this objection has been overcome and should be withdrawn.

2. Indefiniteness

Paragraphs 7-10 of the Office Action reject claims 30 and 31 under 35 USC § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. Specifically, the Office Action alleges that specifically cited portions of those claims are unclear or have an insufficient antecedent basis. In response, applicant has amended claims 30 and 31 to clarify the claims. In light of these claim amendments, applicant submits of this objection has been overcome and should be withdrawn

D. Rejections based on 35 USC § 103

Paragraphs 11-17 of the Office Action reject claims 21 and 30-31 under 35 USC § 103(a) as being unpatentable over U.S. Publication Application No. 2006/0033983 to Dai et al. (“*Dai*”), in view of U.S. Patent Application No. 7,155,097 to Jakobsen et al. (“*Jakobsen*”). Applicant respectfully traverses this rejection and submits that the allegedly obvious combination would not include all of the limitations recited in the claims.

Independent claim 21 recites that the optical fiber uses a core material tellurite glass:

“having a zero-material dispersion wavelength equal to or greater than 2 μm and having a composition of $\text{TeO}_2\text{-Bi}_2\text{O}_3\text{-LO-M}_2\text{O-N}_2\text{O}_3\text{-Q}_2\text{O}_5$, where L is at least one of Zn, Ba and Mg, M is at least one alkaline element selected from Li, Na, K, Rb and Cs, N is at least one of B, La, Ga, Al and Y, and Q is at least one of P and Nb, and components of said tellurite glass are

$50 < \text{TeO}_2 < 90 \text{ (mol\%)}$
 $1 < \text{Bi}_2\text{O}_3 < 30 \text{ (mol\%)}$ and
 $1 < \text{LO} + \text{M}_2\text{O} + \text{N}_2\text{O}_3 + \text{Q}_2\text{O}_5 < 50 \text{ (mol\%)} ”$

Applicant respectfully submits that neither *Dai* nor *Jakobsen*, taken together or separately, disclose or suggest this specific combination of compositions and components. However, in the Office Action, the Examiner notes that the specific combination of compositions and components is recited only in the preamble of claim 21 and as such “is generally not accorded

any patentable weight when the method steps do not depend on the preamble and are able to stand alone.”

In light of this, applicant has amended independent claim 21 to recite within the body of the claim that the first process of molding requires “a tellurite glass melt with said composition and said components,” referring back to the composition and components recited in the preamble. Because the method steps now depend on the recited combination, the specific combination of compositions and components recited in the preamble must now be given patentable weight. Because neither *Dai* nor *Jakobsen*, taken together or separately, disclose or suggest this specific combination of compositions and components, Applicant submits that claim 21 is distinguished over the allegedly obvious combination of *Dai* and *Jakobsen* set forth in the Office Action. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claim 21 be withdrawn.

Claims 30 and 31 depend from claim 21 and thus incorporate the limitations thereof. As such, applicant submits that claims 30 and 31 are distinguished over the cited art for at least the same reasons as discussed above with regard to claim 21. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 30 and 31 also be withdrawn.

No other objections or rejections are set forth in the Office Action.

E. New Claims

Applicant submits that new claims 32-36 are distinguished over the cited art. For example, independent claim 32 recites the same limitations for the glass melt as recited in claim 1. Applicant submits that none of the cited art, taken together or separately, teach these

limitations, as discussed above regarding claim 1. As such, claim 32 is distinguished over the cited art for at least the same reasons as discussed above regarding claim 1.

Claims 33-36 depend from claim 32 and thus incorporate the limitations thereof. As such, applicant submits that claims 33-36 are also distinguished over the cited art for at least the same reasons as discussed above with regard to claim 32.

F. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 21 and 30-36 as amended and presented herein.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 11th day of March 2009.

Respectfully submitted,

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